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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,725	02/05/2001	Timothy M. Swager	M0925/7086 (TJO)	6084

7590 06/27/2005
Timothy J. Oyer
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

EXAMINER

RILEY, JEZIA

ART UNIT PAPER NUMBER

1637

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,725

Applicant(s)

SWAGER, TIMOTHY M.

Examiner

Jezia Riley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 106-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 106-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Remarks

1. Applicants' arguments, filed on 6/13/05, have been approved and entered. They have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 106-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 106 is vague and indefinite because in line 9-10, applicants disclose that B and D can be heteroatom or metal in the main chain and chosen from a group of N-R, P-R, etc. However there is no antecedent basis for the term "the main chain". And there is no description of what R can be, anywhere in the claim.

Claim 107 recites the limitation "and the polymeric composition". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 106-109 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific structure as disclosed in the drawings, does not reasonably provide enablement for the an article comprising any conducting polymer having a structure as broadly claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. There is insufficient guidance in the specification as to make and use the claimed compounds for any article " comprising the conducting polymer" moiety as defined.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described in *In Re Colianni*, 195 USPQ 150 (CCPA 1977) and have been adopted by the Board Appeals and Interferences in *Ex Parte Forman*, USPQ 546 (BPAI 1986).

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Among these factors are: the nature of the invention, the state of the prior art, the predictability or lack thereof in the art, the breadth of the claims, the amount of direction or guidance present, and the presence or absence of working examples.

Breadth of the claims:

The claims are broadly drawn to an article comprising a conducting polymer having a structure comprising the formula as shown in claim 106. Said "conducting polymer" is very broadly defined and therefore reads on an enormous variety of compounds.

Amount of direction/guidance

A broad possible range for the "conducting polymer" moiety is possible and in order to enable the selection of "conducting polymer" there is a need to set forth experimental procedure to be used (how to control the reactive site versus the protective sites, for example). The claimed article is so complexed that it has to comprise multiple reactive sites and therefore required some kind of protection in other site, in order to build said complicated structure. Therefore, it is undue experimentation to synthesize any "conducting polymer", to determine the ones that would be used to prepare the article as claimed in order to practice the broad scope of claim 106 for example. This is clearly an invitation to experiment to select "conducting polymer" to make it specific to prepare said article. These leave the entire work of synthesizing "conducting polymer" up to someone wishing to practice claim 106 which is undue experimentation. The specification gives no guidance to permit one of skill in the art to devise strategies for synthesis of the compounds as claimed except for the ones in the

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Figures. One of ordinary skill in the art would not know how to make any articles that comprise the "conducting polymer" moiety as broadly defined, and how to determine that such a compound would satisfactorily be useful in the nanoscopic approach.

Therefore given the unpredictability of the art and the lack of guidance in the specification, it is the Examiner's position that one skilled in the art could not make and use the article of the claims as broadly recited without undue experimentation.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is 571-272-0786. The examiner can normally be reached on 9:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wednesday, June 22, 2005


JEZIA RILEY
PRIMARY EXAMINER